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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,431	04/22/2004	Ching Man Tsui	033539-021	8776

21839 7590 10/28/2005

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EXAMINER

KOBERT, RUSSELL MARC

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/829,431

Applicant(s)

TSUI ET AL.

Examiner

Russell M. Kobert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-13 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

1. Applicant's arguments filed 29 August 2005 have been fully considered but they are not persuasive. In response to applicant's argument that "the claims are directed to an apparatus for supporting these components during testing," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Tsurishima et al (5227717) is an apparatus "capable" of supporting during a testing operation a leadframe formed with at least one row of non-singulated semiconductor devices. Tsurishima et al comprises "connection leads" (112) shown in Figure 4 that is capable of receiving leads of non-singulated semiconductor devices. Therefore Tsurishima et al meet the criteria of being "capable" for the intended use. Moreover, Applicants openly admit in the Response filed 29 August 2005 that "the recitation of these elements in the claim is for the purpose of describing the intended use of the support apparatus." Furthermore, Applicants openly admit that "the claims are directed to the support apparatus, per se. The leadframe and semiconductor devices are not positively recited elements of the claim." Thus Applicants have limited the claimed invention to the apparatus exclusive from the device under test. Further arguments that the device under test defines the structure of the claimed features of the support apparatus will bear no further patentable weight to the claimed apparatus. As such the objection to the drawings is hereby withdrawn because the claimed invention is exclusionary to the "leadframe formed with at least one row of non-singulated semiconductor devices." Further arguments with respect to the features

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of a leadframe are moot in view of Applicants own admission as noted supra. To summarize, Tsurishima et al clearly anticipates the claimed invention in view of Applicants own remarks.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 and 8-13 are rejected under 35 U.S.C. 102(b) as being **clearly** anticipated by Tsurishima et al (5227717).

Tsurishima et al anticipates an apparatus (Figure 6) for supporting during a testing operation a leadframe (99) formed with at least one row of non-singulated semiconductor devices (plurality of carrier modules 22 aligned within the frame 98), comprising a main body (70) and a leadframe support member (24), wherein said leadframe support member is formed with at least one groove (that portion bounded by frame 98) for receiving said semiconductor devices such that in use leads extending from said devices lie on a surface of said support member; as recited in claim 1.

As to claim 2, Tsurishima et al anticipates the leadframe support member being formed by a plurality of parallel grooves (note 4 parallel and bounded regions).

As to claim 3, Tsurishima et al anticipates means (96) for releasably gripping the leadframe.

As to claim 4, Tsurishima et al anticipates the gripping means comprising a pair of gripping members disposed on respective sides of the groove (see items 96 on opposite sides of 24).

As to claim 5, having means for moving the gripping members into and out of engagement with the leadframe is anticipated by Tsurishima et al (col 9, ln 67 - col 10, ln 2).

As to claim 8, having the gripping means extended through apertures formed in the leadframe support member is anticipated by Tsurishima et al (note rotors 96 partially inserted to dashed line in frame 99)

As to claim 9, having locating pins (97; see Figure 4) for locating the leadframe support member on the main body (70) is anticipated by Tsurishima et al.

As to claim 10, having the main body formed of conducting material and provided with means for electrically grounding the main body is considered an intrinsic property of the apparatus of Tsurishima et al.

As to claim 11, having the leadframe support member formed of a highly resistive insulating material is considered an intrinsic property of the apparatus of Tsurishima et al.

As to claim 12, having the main body provided with identification means is considered to be within the scope of normal practice of Tsurishima et al.

As to claim 13, having means for coupling the main body with a transport mechanism is anticipated by Tsurishima et al (note the coupling portion between 70 and 96 shown in Figure 4).

4. The following is a statement of reasons for the indication of allowable subject matter:

Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The added limitation of the moving means being actuated by compressed air as described in claim 6 has not been found. It is further noted that the examiner's reasons are understood to be predicated upon consideration of each of the claims as a whole, and not upon any specific elements of the claims.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kobert whose telephone number is (571) 272-1963.

The Examiner's Supervisor, Nestor R. Ramirez, can be reached at (571) 272-2034.

For an automated menu of Tech Center 2800 phone numbers call (571) 272-2800.



Russell M. Kobert
Patent Examiner
Group Art Unit 2829
October 21, 2005



VINH NGUYEN
PRIMARY EXAMINER
A-U-2829
10/27/05